

Pollet et al, 5,024,890, 5,312,687, and 5,387,468. Rejections on the newly cited reference(s) follow." Office Action at 2. In response, Applicants note that it was claim 3, not claim 5, that was previously indicated by the Examiner to contain allowable subject matter. See Office Action dated October 23, 2002, at page 4. Moreover, Applicants note that claim 5, which is currently pending, was not rejected in the outstanding Office Action. Accordingly, Applicants request indication from the Examiner that claim 5 as currently pending is directed to allowable subject matter.

Applicants acknowledge and appreciate that the rejection of claims 1, 2, 4-8, 13, 14, and 18-32 under 35 U.S.C. § 103(a) over Japanese Patent Publication No. 208,268 to Sugano ("*Sugano*") in view of Japanese Patent Publication No. 5-110218 to Sasaki ("*Sasaki*") was withdrawn.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner has newly rejected claims 1, 4, 6-8, 13, 14, and 18-32 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 208,268 to Sugano ("*Sugano*") in view of Japanese Patent Publication No. 5-110218 to Sasaki ("*Sasaki*") and U.S. Pat. Nos. 5,024,890, 5,312,687, and 5,387,468 to Pollet et al (collectively "*Pollet*") for the reasons set forth on pages 2-4 of the Office Action dated April 9, 2003. Applicants respectfully submit that this prior art fails to render obvious the invention recited in the pending claims.

To establish a prima facie case of obviousness, the Examiner must meet three basic criteria, as set forth in M.P.E.P. § 2143. First, there must be some suggestion or

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motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references when combined must teach or suggest all the claim limitations. M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In this case, Applicants assert at the least that there is no motivation in the references to combine their teachings, and even if the teachings were combined, the resulting combination would still fail to teach the claimed invention.

A. No Suggestion or Motivation to Combine the References

The Federal Circuit has held that there must be a clear and particular suggestion in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak* 50 USPQ.2d 1614, 1617 (Fed. Cir. 1999).

The Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to

combine the relevant teachings of the references.” *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added).

The Federal Circuit again reaffirmed the Examiner’s high burden to establish a *prima facie* case of obviousness in *In re Sang-Su Lee*, and emphasized the requirement for specificity. In *In re Sang-Su Lee*, the Federal Circuit held that “[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Sang-Su Lee*, 61 U.S.P.Q.2d 1430,1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Sang-Su Lee at 1433-1434 (internal citations and quotation omitted) (emphasis added).

In the present case, the Examiner alleges that *Sugano* “does not specifically teach a powdered coating, the specific glass fibers used or boron nitride particles” that are present in the current application. Office Action at 3. The Examiner then relies on *Sasaki* to provide the suggestion of the specific glass fibers and the boron nitride particles, and *Pollet* for the suggestion of the powdered coating. Applicants respectfully submit that the requisite objective teaching to combine the references is not present.

In relying on *Sasaki* to teach the use of boron nitride particles, the Examiner suggests a reason for combining this aspect of *Sasaki* with *Sugano*: "to increase the lubricity of the glass fibers." Office Action at 4. However, this reasoning is not discussed in *Sasaki* itself and the Examiner does not show another source for this reasoning, thereby failing to provide the requisite objective teaching. The Examiner does not specifically state why one skilled in the art would have been motivated to choose boron nitride for use in the instant application. The Examiner's reason for combining the powder aspect of *Pollet* with *Sasaki* and *Sugano*, "to improve the bonding of the inorganic particles to the fabric surfaces" (Office Action at 4), is similarly unsupported for the reason that the Examiner has not demonstrated how or why a powder is advantageous, and why one skilled in the art would have been motivated to include this aspect in the present application. Applicants therefore respectfully submit that an objective teaching to combine the references has not been demonstrated.

Additionally, Applicants assert that *Pollet* does not actually teach the idea of a powdered coating. The powders referred to in *Pollet* are the thermoplastic resin in powder form and the supplementary filler in powder form. Col. 3, lines 39-68. In contrast, claim 1 of the application for the current invention describes the entire coating as "powdered." Without a teaching of a powdered coating, there can be no motivation to combine a powdered coating with *Saskai* or *Sugano*.

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B. Prior Art Must Teach or Suggest All the Claim Limitations

As stated above, an examiner must also show that the prior art teaches or suggests all of the claim limitations in order to establish a prima facie case of obviousness. See *In re Royka*, 180 U.S.P.Q 580 (C.C.P.A. 1974)). Additionally, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)). Applicants respectfully submit that the rejected claims are patentably distinguishable from the prior art at least because the prior art fails to teach or suggest each and every claim limitation.

Applicants respectfully submit that the prior art relied upon by the Examiner, taken alone or combination, fails to teach or suggest a “resin compatible powdered coating composition” as recited in the independent claims. The Examiner attempts to rely on *Pollet* to teach such a powdered coating, and points to the ‘890 patent to disclose that “organic or inorganic particulates can be either pre-combined with the polymer so that each powder particle contains polymer and filler or be added separately as a powder.” Office Action at 3, and the ‘890 patent at col. 4, lines 5-7. Applicants respectfully submit that the Examiner has misinterpreted *Pollet*.

In contrast to the Examiner’s statement, *Pollet* actually discloses using a slurry, rather than a powdered coating, to coat the fibers disclosed in the references. For example, the ‘890 patent discloses that “the present invention relates to a slurry composition” (col. 2, line 23), “the composition of this invention may contain a carrier

solvent, normally water, . . . and a matrix thermoplastic resin powder dispersed in the sizing to form a slurry" (col. 2, lines 45-49), and "the sizing composition suspends the thermoplastic powder particles in the slurry" (col. 3, lines 39-41). Additionally, the chart set forth in col. 4 of the '890 patent discloses slurry compositions comprising water, generally in an amount of 58-60%. These slurry compositions are aqueous coating compositions, rather than the powdered coating composition recited in independent claim 1.

Moreover, the passage relied upon by the Examiner in the Office Action, set forth in its entirety below, also discloses the use of a slurry, rather than a powdered coating composition.

It is also within the contemplated scope of this invention that organic or inorganic particulates, such as metallic fillers useful in producing conductive rovings, may also be used with the thermoplastic polymer particles. These fillers can be either pre-combined with the polymer so that each powder particle contains polymer and filler or be added separately as a powder to the slurry.

Col. 4, lines 1-8 (emphasis added). Thus, even the passage relied upon by the Examiner for teaching a powdered coating actually teaches a slurry coating.

Nothing in Pollet discloses the use of a powdered coating composition, which is distinct from an aqueous coating composition. Thus, the prior art cited by the Examiner does not teach all of the claim limitations and Applicants respectfully submit that a prima facie case of obviousness has not been established as to claims 1, 4, 6-8, 13, 14, and 18-32.

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III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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